

REMARKS

By this amendment, claims 1-40 are pending, in which no claim is canceled, withdrawn, currently amended, or newly presented. No new matter is introduced.

The Office Action mailed June 7, 2006 rejected claims 1, 5-9, 13-17, 21-25, 29-33, and 37-40 under 35 U.S.C. § 103(a) as obvious based on *Cox et al.* (US App. Pub. 2002/0115431 A1) in view of *Gerszberg et al.* (US 6,052,439) and in further view of *BOC Expands Directory Options*, BOC WEEK, Jan. 13, 1992 (hereinafter *BOC*), and claims 2-4, 10-12, 18-20, 26-28, and 34-36 as obvious under 35 U.S.C. § 103(a) based on *Cox et al.* in view of *Gerszberg et al.* and *BOC* and in further view of *Shah et al.* (US 6,212,506 B1).

Regarding the rejections of record, Applicants respectfully traverse on the merits for the reasons proffered below.

Independent claim 1 recites, “**in response to a selection of more than one of the directory listings** from the client access device, **transmitting a plurality of listing numbers to the client access device**; and preparing billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device.” Claim 9 recites, “**in response to a selection of more than one of the directory listings** from the client access device, **transmitting a plurality of listing numbers** to the client access device” and “a processor configured to prepare billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device.” Claim 17 recites, “means for transmitting a plurality of listing numbers to the client access device **in response to a selection of more than one of the directory listings** from the client access device; and means for preparing billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device.” Claim 25 recites, “**in response to a selection of more than one of the directory listings** from the client access device, **transmitting a plurality of**

**listing numbers** to the client access device” and “a server configured to prepare billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device.” Claim 33 recites, “**transmitting a plurality of listing numbers** to the client access device **in response to a selection of more than one of the directory listings** from the client access device; and preparing billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device.”

In response to Applicants’ arguments of April 3, 2006, the present Office Action, on page 6, states that those arguments were “fully considered” and deemed “persuasive.” Nevertheless, at this late stage of prosecution, the Examiner persists in continuing to unearth new references to combine with the primary reference of *Cox et al.*, despite the fact that doing so would violate the basic tenets of obviousness determination. For instance, the proposed modification still undercuts the express objectives of *Cox et al.*, as previously explained in Applicants’ Response of April 3, 2006, on page 15. At this point, the Office Action is so focused on the claim language of “preparing billing information based upon a number of the plurality of listing numbers transmitted” that the Examiner ignores the claim language of “directory listings,” particularly in the context of the entire claim: “transmitting a plurality of **listing numbers** to the client access device **in response to a selection of more than one of the directory listings.**” This key distinction was pointed out nearly a year ago in Applicants’ Response dated Oct. 31, 2005 (page 15). Applicants submit that even with the addition of *BOC*, the applied references taken alone, or in combination, fails to teach, or even reasonably suggest, these claimed features. At best, one of ordinary skill in the art would reasonably interpret the references as providing listing numbers in response to user queries, but this falls short of the positively claimed features.

*Cox et al.* is directed to a telecommunications technique for providing information assistance wherein directory assistance services and billing services are divorced from one

another, (see paragraphs [0008] and [0041]-[0047]). More particularly, the directory assistance provider merely logs information identifying the customer, the destination number to which the customer is connected, as well as the date, time, and duration of the destination connection, (paragraph [0008]). This information is periodically provided to the cellular carrier for billing purposes. (*Id.*). In this manner, the *Cox et al.* system makes it “**the cellular carrier’s responsibility** to rate the calls and determine what charge is to be levied” not the provider of the directory assistance service, (see paragraph [0047]).

Contrary to the *Cox et al.* disclosure, the Examiner suggests combining *Cox et al.* with *Gerszberg et al.* and *BOC* to make the directory assistance service provider assume the responsibility of determining what to charge. As such, the Examiner attempts to pick and choose from *Cox et al.* only those portions that will support her proposition to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. This is impermissible. *See In re Wesslau*, 147 USPQ 391 (C.C.P.A. 1965); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). *See also* M.P.E.P. §§ 2141.02 and 2143.

Even assuming the many references were properly combined based on some teaching or suggestion in the references, and assuming the modifications proposed in the Office Action were justified by additional teachings or suggestions found in the references, even the combination does not render the claimed invention obvious. The proposed combination of *Cox et al.*, *Gerszberg et al.*, and *BOC* fails to teach, or even suggest, the claimed features of “**in response to a selection of more than one of the directory listings** from the client access device, **transmitting a plurality of listing numbers** to the client access device.” The Office Action, on page 2, acknowledges that *Cox et al.* “fails to teach transmitting information associated with one or more directory listings to a client access device over the packet switched network in response to a

query initiated by a customer, wherein the customer selects one or more of the directory listings based on the information.” Applicants’ study of *Cox et al.* reveals, at best, that an operator can audibly provide callers a desired number when requested; however, this does not teach, “**in response to a selection of more than one of the directory listings from the client access device, transmitting a plurality of listing numbers to the client access device.**”

Further, the Examiner only relies on *Gerszberg et al.* for a supposed teaching of “information being sent to a customer’s device according to the customer query” (Office Action, page 3). *Gerszberg et al.* describes a server configured, in part, to provide “automated directory assistance services for **telephone number listings**” (col. 7: 39-44). When implementing this embodiment, the *Gerszberg et al.* system enables a user to initiate a directory assistance query, such as “look up Tom Jones” (col. 7: 62-66), and receive the telephone number listing as either displayed text or audible sounds (col. 8: 18-24). After query results are provided, a user can either select options for obtaining yellow pages or toll-free directory pages information (including information about company products, services, and/or webpage links) or for automatic dialing of a particular telephone number listing, (col. 8: 25-32). As such, *Gerszberg et al.* provides a system wherein query results comprise telephone number listings as the directory listing and, therefore, also fails to teach the claimed features.

With respect to the newly applied reference of *BOC* remains, the Examiner applies *BOC* for a supposed teaching of a “directory assistance that allows users to receive multiple listings and a process for charging the user for multiple listings” (Office Action, page 3). Applicants’ study of the reference merely reveals a general accounting of what the Southwestern Bell system “**will be able to do.**” not what can be performed at the time of the disclosure, (*see* line 8). *BOC* is devoid of any disclosure teaching one of ordinary skill how to make and use the proposed features, and thus, would be a nonenabling disclosure. A nonenabling disclosure cannot

constitute a proper prior art reference. *See, e.g., Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ 2d 1481, 1489 (Fed. Cir. 1997) (holding that “[i]n order to render a claimed apparatus or method obvious, the prior art **must enable** one skilled in the art to make and use the apparatus or method.”). Therefore, while the Office Action acknowledges (by its omission) that *BOC* does not teach “**in response to a selection of** more than one of the **directory listings** from the client access device, **transmitting** a plurality of **listing numbers** to the client access device,” the reference cannot be applied to teach “preparing billing information **based upon a number of the plurality of listing numbers transmitted** to the client access device,” either.

In view of the foregoing, it is clear that a *prima facie* case for obviousness has not been established. Applicants, therefore, respectfully solicit the withdrawal of the obviousness rejection to independent claims 1, 9, 17, 25, and 33, as well as claims 5-8, 13-16, 21-24, 29-32, and 37-40, depending correspondingly therefrom, and urge the indication that these claims are in condition for allowance.

As for the obviousness rejection of claims 2-4, 10-12, 18-20, 26-28, and 34-36, the secondary reference of *Shah et al.* does not cure the deficiencies of *Cox et al.*, *Gerszberg et al.* and *BOC*. *Shah et al.* is merely relied upon for a supposed teaching of “a system and method of a customer database used to determine rates for calls and routing information,” (Office Action, page 5). As such, a *prima facie* case of obviousness has not been established. Furthermore, Applicants direct the Examiner’s attention to the Response of April 3, 2006, pages 16-17, where it was shown that these dependent claims were allowable on their own merits. Applicants, therefore, request withdrawal of the rejection.

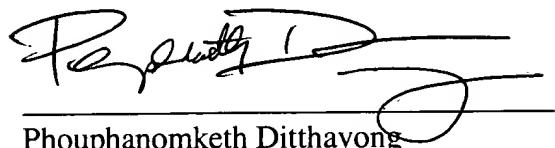
Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the

undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

DITTHAVONG & MORI, P.C.

9/6/06  
Date



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